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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK L. TRAVELUTE III and GLEN P. REESE

Appeal 2010-000475
Application 10/813,893
Technology Center 1700

Before EDWARD C. KIMLIN, ADRIENE LEPIANE HANLON, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL¹

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision dated December 7, 2007 to finally reject claims 1-9, 11, 13-16, 20,

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

21, 40, 41, 43, 45-48, 51-57, and 60 (*See* Notice of Appeal dated May 5, 2008). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants' invention relates to synthetic, low density, light weight polyester filaments and fibers (Spec. ¶ [0001]). Claim 1 is illustrative:

1. A lightweight, low density foamed fiber consisting essentially of:

a copolymer of polyester and polyethylene glycol, with the polyethylene glycol being present in an amount of between about 6 and 10 percent by weight, said copolymer having a greater elasticity than a corresponding monomer-based polyester;

more than thirty five percent functional void fraction in the form of foam-forming cells for reducing the density of the fiber as compared to a solid fiber;

at least five void cells per axial cross section for increasing the structural integrity of the fiber as compared to less uniform foams; and

submicron-sized particles of a fluorocarbon nucleating agent, present in an amount less than 10 percent by weight.

The Examiner relies upon the following evidence:

<u>First Named Inventor</u>	<u>Document No.</u>	<u>Issue or Pub. Date</u>
Siggel	US 4,164,603	Aug. 14, 1979
Soehngen	US 4,290,987	Sep. 22, 1981
Li	US 4,626,390	Dec. 2, 1986
Travelute	US 5,407,625	Apr. 18, 1995
Nichols	US 6,485,829 B2	Nov. 26, 2002
Travelute	US 2006/0057359 A1	Mar. 16, 2006
Edwards	US 2007/0059511 A1	Mar. 15, 2007

Sato

JP 08-260285²

Oct. 8, 1996

The Examiner maintains the following rejections:

1. The rejection of claims 1-6, 11, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Siggel in view of Nichols and Soehngen;
2. The rejection of claims 8, 9, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Siggel in view of Nichols, Soehngen, and Sato;
3. The rejection of claims 55-57 and 60 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Li;
4. The rejection of claims 1-7, 11, and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Li in view of Nichols;
5. The rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over Li in view of Nichols and Soehngen;
6. The rejection of claims 8, 9, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Li in view of Nichols and Sato;
7. The rejection of claims 40, 41, 43, 45-48, and 51-54 under 35 U.S.C. § 103(a) as unpatentable over Li in view of Nichols and Travelute;
8. The provisional rejection of claims 1-9, 11, 13-16, 20, 21, 40, 41, 43, 45-48, 51-57, and 60 under the doctrine of obviousness-type double patenting as unpatentable over claims 1-67 of U.S. Patent Application No. 11/244,687 (US 2006/0057359 A1); and
9. The provisional rejection of claims 1-9, 11, 13-16, 20, 21, 40, 41, 43, 45-48, 51-57, and 60 under the doctrine of obviousness-type double

² The Examiner cites to the Patent Abstracts of Japan English Abstract made of record in an Office Communication dated December 6, 2005. A full

patenting as unpatentable over claims 1-48 of U.S. Patent Application No. 11/364,242 (US 2007/0059511 A1).

Appellants appeal only the first two of the above listed rejections, i.e., the rejections based primarily on Siggel, Nichols, and Soehngen (Br. 5 and 8). While the Examiner adds Sato to reject claims 8, 9, 20, and 21, Appellants addresses both rejections with a single argument focused on the limitations of claim 1 (Br. 9-13). Therefore, our focus will necessarily be on claim 1 for deciding the issue arising from Appellants' argument.

II. DISPOSITIVE ISSUE

The dispositive issue arising from the contentions of Appellants and the Examiner is: does the evidence support the Appellants' view that the presence of silicone oil materially affects the basis and novel characteristics of Appellants' claimed invention, such that the "consisting essentially of" language of claim 1 excludes prior art, such as Siggel, that teaches including silicone oil? We answer this question in the negative.

III. DISCUSSION

We adopt the Examiner's findings in the Answer as our own and add any additional findings of fact appearing below for emphasis.

Appellants contend that Siggel provides sufficient evidence that the inclusion of silicone oil is essential to the production of "a plurality of adjacent, separate, discontinuous cavities," such that its inclusion materially affects the basic and novel characteristics of the claimed invention, which produces such cavities without the need for silicone oil (Br. 9-13).

English translation of the Japanese document was made of record on May 28, 2009.

The Examiner contends that “Appellants have not provided any factual evidence indicating that the silicone oil may materially change the density, porosity of the filaments and/or the shapes, diameters of the discrete cavities” (Ans. 13).

The “phrase ‘consisting essentially of’ limits the scope of a claim to the specified ingredients and those that do not *materially affect* the *basic* and *novel* characteristic(s) of a composition.” *In re Herz*, 537 F.2d 549, 551-52 (CCPA 1976) (emphasis added). In assessing a broadest reasonable claim construction wherein a potentially exclusionary “consisting essentially of” transitional phrase is involved, Appellants bear the burden of: (1) showing the basic and novel characteristics of their claimed invention, and (2) establishing how those characteristics would be materially changed by the presence of any component included in an applied reference but not recited as an element in the claims. *See In re DeLajarte*, 337 F.2d 870, 873-74 (CCPA 1964); *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (BPAI 1989).

The written description in Appellants’ Specification must be considered in determining whether Appellants have met this burden. *Herz*, 537 F.2d at 551 (“[I]t is necessary and proper to determine whether [the] specification reasonably supports a construction” that would exclude or include particular ingredients.); *see also PPG Indus., Inc. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed. Cir. 1998) (Patentees “could have defined the scope of the phrase ‘consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention. The question for our decision is whether PPG did so.”).

Appellants' reliance on the holding of *In re Garnero*, 412 F.2d 276, 279 (CCPA 1969), is misplaced because the facts of *Garnero* differ from those presented here. In *Garnero*, the basic and novel characteristics were apparent and specifically recited in the claim at issue, i.e., that the perlite particles were "interbonded to one another by interfusion." *Garnero*, 412 F.2d at 279. Accordingly, the presence of an additional binder would affect the perlite being held together specifically "by interfusion." *Id.* Thus, we do not agree that *Garnero* stands for the general principle proposed by Appellants that "one of the basic and novel characteristics of a claimed invention may be its exclusion of an element which the prior art teaches is necessary" (Br. 12). Rather, *Garnero* supports the holdings of *Herz* and *PPG* that Appellants' Specification should clarify what is regarded as constituting a material change in the basic and novel characteristics of the invention.

We find no disclosure in Appellants' Specification which defines the term "consisting essentially of" language in claim 1 with respect to the inclusion of silicone oil or that clearly establishes that the invention would be materially changed by the addition of silicone oil. Indeed, Appellants' Specification is completely silent as to the use of silicone oil and consistently uses open "comprising" language, suggesting that the inclusion of additional materials would not materially affect the invention (*See e.g.*, Spec. ¶¶ [0011]-[0013]).

Moreover, Appellants' Specification fails to clearly set forth that a plurality of adjacent, separate, discontinuous cavities constitutes the basic and novel characteristics of the claimed invention, as argued by Appellants (Br. 9 and 11). To the contrary, Appellants' Specification indicates that low

density foamed polymers are well established in the art (Spec. ¶ [0007]) and seems to suggest that the basic and novel characteristics of the invention is the large void fraction obtained by the presence of several small cells, rather than the conventional use of large cells to reduce fiber density (*see* Spec. ¶¶ [0020] and [0023]). Appellants do not contest that the claimed void fraction and number of cells per cross-section are taught by the prior art.

Further, we do not subscribe to Appellants' position that the teachings of Siggel prove the basic and novel characteristics of Appellants' invention. While we agree with Appellants that Siggel teaches that silicone oil is necessary for its invention, we do not find a sufficient teaching in Siggel to prove that silicone oil is essential to produce adjacent, separate, and discontinuous cavities, as argued by Appellants.

To the contrary, Siggel teaches that filaments with small, separate cavities were known in the art (Siggel, col. 1, ll. 9-16). Siggel fails to explain what specific function the silicone oil performs in its invention. However, Siggel discloses that silicone oil is known to improve the gliding properties of the polymer in the extruder and possibly functions as a plasticizer (Siggel, col. 4, ll. 49-53), and Siggel theorizes that improvements in spinneret running times can be attributed to the use of silicone oil (Siggel, col. 5, l. 65 to col. 6, l. 13).

Accordingly, the teachings of Siggel are insufficient to prove that the inclusion of silicone oil would necessarily affect the formation of adjacent, separate, and discontinuous cavities in Appellants' invention.

Accordingly, we sustain the Examiner's rejections.

IV. REMAINING REJECTIONS

Appellants did not present any arguments rebutting the remaining rejections under 35 U.S.C. § 102 or § 103 and did not list or rebut the obviousness-type double patenting rejections (Br. 4-5 and 8). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008); MPEP § 1205.02 (8th Ed., Rev. 7, July 2008) (“If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.”). As such, we summarily sustain the remaining rejections.

V. CONCLUSION

On the record before us and for the reasons discussed above, we sustain the rejections maintained by the Examiner.

VI. DECISION

The decision of the Examiner is affirmed.

VII. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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